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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|--------------------|
| 10/781,566 | 02/18/2004 | Robert Workman | 2450.PCRA.PT | 9298 |
| 26986 | 7590 | 08/10/2005 | EXAMINER | |
| MORRISS O'BRYANT COMPAGNI, P.C. 136 SOUTH MAIN STREET SUITE 700 SALT LAKE CITY, UT 84101 | | | | WILLIAMS, JAMILA O |
| ART UNIT | | PAPER NUMBER | | |
| | | | | 3722 |

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/781,566 | WORKMAN ET AL. | |
| | Examiner | Art Unit | |
| | Jamila O. Williams | 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on application filed 2-18-2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
 - 4a) Of the above claim(s) 2,6-8,16 and 20-22 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-5,9-15,17-19 and 23-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5-25-04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: Group I, Claims 1,3-5, 9-15,17-19, 23-27, Figures 1-4; Group II, Claims 2,16, Figures 7a,b; Group III, Claims 6-8, 20-22, Figures 5-6.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Frank Compagni on August 4,2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1,3-5, 9-15,17-19, 23-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2, 6-8,16, 20-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claim 24 is objected to because of the following informalities: There are two claims represented by number "24". Appropriate correction is required.

Claim 26 is objected to because of the following informalities: The text at the end of the claim, "15. A method for customizing an album, said method comprising:", appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,4,5,9,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,850,705 to Groh. Groh discloses a front and back sheet of plastic material, forming a sleeve thereinbetween (22), a plurality of pockets formed on the front of the sheet, each having a living hinge and each of the first and second sheets (forming the pockets) is less than the size of the front sheet. Groh discloses that the back sheet (14) is constructed of light weight plastic, front sheet (20) is composed of clear plastic material and that the pockets (26) are configured such that they can be flipped upward in order to view the rear side of the item located therein (circuit board). This would suggest that these pockets are in fact transparent. Although it is not clearly stated that sheet 14 and pockets 26 are transparent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use transparent material to provide the user with better visibility. Groh further discloses that the pockets are positioned in a stacked arrangement to partially overlap the adjacent pocket (fig 1); wherein the plurality of sheets form a margin (see figure 1, area between opening 22 and pockets 26 that allows for visibility of sheet 24) and the living hinge is formed by a plastic weld (col. 4 ln. 20).

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Regarding the limitations of claim 10 wherein the front and back sheets are attached by heat welding to form seams along at least 3 edges, in that this is a product claim the process or method steps are not germane to the issue of patentability of the product itself and therefore the process limitations have not been given patentable weight. Groh discloses a front and back sheet attached to form a pocket therebetween.

Regarding the limitations of claims 13-14 and 26-27 (towards the size of the pockets and front and back sheets), applicant has given no criticality to these sizes and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the size of the sheets and pockets of Groh as suited for the intended use.

Claims 11-12,24,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,850,705 to Groh in view of 3,091,046 to Engelstein et al . Groh discloses all of the elements of the claims as applied to claim 1 above. Groh does not however disclose having a binding portion to engage a binder. Engelstein discloses a sheet having a binding portion (12) on the side of the sheet for engagement with a binder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the binding portion of Engelstein with the sheets of Groh for the purpose of allowing the sheets to be stored in a binder.

Claims 15,17-19,23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,850,705 to Groh in view of 5,722,694 to Baldursson. Groh discloses all of the elements of the claims but for the binder and binding structure.

Baldursson discloses a binder having a binder portion (binder 34 binding structure 32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to store several of the sheets as taught by Groh in the binder of Baldursson for the purpose of providing safe storage for the sheets.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

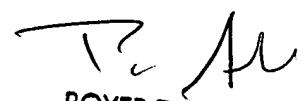
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Mon-Fri 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jw

gn 8/8/05


BOYER D. ASHLEY
PRIMARY EXAMINER